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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,632	01/03/2002	Douglas C. Williams	69035-001	6756

7590 03/02/2004

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EXAMINER

EGAN, BRIAN P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,632

Applicant(s)

WILLIAMS, DOUGLAS C.

Examiner

Brian P. Egan

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9, 11, 12 and 24-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9, 11, 12 and 24-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Interpretation*

1. In light of the Applicant's amended claims and remarks, the Examiner has given patentable weight to the limitation that the article is "pre-assembled." The Examiner notes, however, that the newly added claim 25 has not been given patentable weight since the method of application (i.e. spraying) is directed at the process of forming the article and not germane to the patentability of the article itself.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9, 11-12, and 24-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (#5,096,759) in view of Harkness (#4,775,567), Diamond (#4,194,335), and Zickell et al. (#4,992,315).

Simpson et al. teach an article of manufacture for reducing water damage on a roof comprising a sheathing panel for assembling on the roof rafters having a first face and a second face (see Fig. 10), a high density polyethylene film layer (Col. 1, lines 50-56), an adhesive layer (Fig. 1, #24), and a plastic film covering the adhesive layer (Fig. 1, #26). The article comprises means for removing the plastic film to expose the adhesive backing and means for assembling

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the article to the sheathing panel (see Fig. 2; Col. 5, lines 55-62). The article comprises marking means for positioning a corner of the article at a corner of the sheathing panel and aligning their longitudinal edges (Col. 4, lines 8-17). Although Simpson et al. do not explicitly teach that the article either completely covers or covers approximately three-fourths of the first face of the sheathing panel, Simpson et al. teach that the roofing is manufactured to be wound into a spiral roll and cut to appropriate sizes. Therefore, depending on the desired end product, it would have been obvious to change the size of the roofing material such that it either completely covers or covers three-fourths of the first face of the sheathing panel (Col. 2, lines 4-9). Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the size of the article such that it either completely covers or covers three-fourths of the sheathing panel since such a modification would have involved a mere change in the size of a component – a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Simpson et al. further teach that the roofing material is arranged in such a way so as to prevent leaks (Col. 5, lines 43-47) but fail to explicitly state that the high density polyethylene film layer is water, vapor, and ice resistant.

Harkness, however, teaches a waterproofing laminate for use in roofs wherein the waterproofing laminate material is selected from multiple different polyethylene materials (Col. 3, lines 1-6). The waterproofing laminate is used for the purpose of resisting undesired penetration of water ("water" implicitly includes ice) and water vapor (Col. 2, lines 14-17). It would have been obvious through routine experimentation to one of ordinary skill in the art to select a polyethylene based material based on its waterproofing properties for the purpose of

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providing a roofing laminate that resists undesired penetration of water and water vapor as taught by Harkness.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Simpson et al. to replace the high density polyethylene laminate with a polyethylene waterproofing laminate as taught by Harkness in order to provide a roofing laminate that resists undesired penetration of water and water vapor.

Simpson et al. further fail to teach whether the moisture barrier layer may be pre-assembled with the sheathing panel. It is notoriously well known in the art, however, to provide weatherproof roof panels comprising a sheathing panel and a moisture barrier layer that are prefabricated as evidenced by Diamond (see Abstract; Col. 3, lines 29-40). Diamond teaches the use of a prefabricated article for the purpose of providing a substrate that may be sold as an entire unit and then transferred to a jobsite and be lifted and applied by a carpenter (Col. 2, lines 21-26). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Simpson et al. and Diamond since each of the aforementioned references are analogous insofar as being directed at weatherproofing roofing substrates – Diamond ultimately providing a comparative advantage over Simpson et al. insofar as improving the ease of handling and installation of the article.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Simpson et al. by providing the weatherproof substrate in combination with the sheathing material in a pre-assembled manner as taught by Diamond in order to provide a substrate that may be sold as an entire unit and subsequently

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transferred to a jobsite and lifted and applied by a carpenter – ultimately improving the installation process.

Finally, Simpson et al. do not explicitly state that the polymeric weatherproof layer seals around fasteners passing through the layer. It is notoriously well known in the art, however, to select polymeric material that has been sufficiently rubberized such that a seal is formed around roofing nail punctures as evidenced by Zickell et al. (Col. 3, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have combined the teachings of Simpson et al. and Zickell et al. since each of the aforementioned references are analogous insofar as providing weatherproof sealing material – Zickell et al. providing a comparative advantage insofar as providing a rubberized polymeric material that seals around nails driven through the layer.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Simpson et al. to include a sufficient amount of rubberized polymeric material as taught by Zickell et al. in order to ensure that a seal will be formed around nails and other fasteners driven through the weatherproof layer.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 9, 11-12, and 24-36 have been considered but are moot in view of the new ground(s) of rejection.

Pursuant to the Applicant's amended claims and response, the Examiner has withdrawn the objection to the Abstract from the previous office action and has also withdrawn the 35 U.S.C. 112 rejections from the previous office action.

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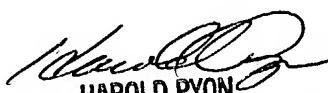
*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 571-272-1491. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
BPE 2/11/04

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

2/20/04